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09/114,027	07/10/1998	CAROLINE M. YLITALO	53092USA8A	8735

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PHILIP Y DAHL
3M OFFICE OF INTELL PROPERTY COUNSEL
P O BOX 33427
ST PAUL, MN 551333427

EXAMINER

ZIRKER, DANIEL R

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 21

Serial Number: 09/114,027
Filing Date: July 10, 1998
Appellant(s): Ylitalo et al.

Philip Y. Dahl
For Appellants

MAILED
OCT 17 2002
GROUP 1/00

EXAMINER'S ANSWER

1. This is in response to Appellants' Brief on appeal filed July 12, 2002.

2. *(1) Real Party in Interest*

3. A statement identifying the real party in interest is contained in the Brief.

4. *(2) Related Appeals and Interferences*

5. A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the Brief.

6. *(3) Status of Claims*

7. Claims 1, 2, 7-10, 15 and 16 are rejected and are appealed. Claims 3-6, 11-14 and 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if

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rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. (4) *Status of Amendments After Final*

9. The Appellants' statement of the status of amendments after final rejection contained in the Brief is correct.

10. (5) *Summary of Invention*

11. The summary of invention contained in the Brief is deficient because while otherwise essentially correct, Appellants' assertion of "superior melt extrusion properties" and "improved adhesive properties" have never been proven on the record.

12. (6) *Issues*

13. The Appellants' statement of the issues in the Brief is substantially correct. The changes are as follows: The Examiner's rejection of claims 3-6, 11-14 and 17-20 as unpatentable over the prior art of record has been withdrawn, and these claims are now only objected to as being dependent upon a rejected base claim. This former rejection encompassed Appellants' issue B.

14. (7) *Grouping of Claims*

15. The Examiner acknowledges Appellants' grouping of claims 1, 2, 7-10, 15 and 16 as standing or falling together depending upon the determination of issues of patentability with respect to claim 1.

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16. (8) *Claims Appealed*

17. The copy of the appealed claims contained in the Appendix to the Brief is correct.

18. (9) *Prior Art of Record*

19. The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

JP Derwent Abstract XP 002118059 (JP -059 Abstract) August 21, 1997

JP Derwent Abstract XP 002118060 (JP -060 Abstract) May 27, 1994

20. (10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

21. Claims 1, 2, 7-10, 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -060 Abstract. The reference discloses in several embodiments a pressure sensitive adhesive (i.e., self adhesive) composition which contains a thermoplastic polymer having substantially no epoxy-binding functions or ester functions, a tackifier, and a thermosetting resin (such as an epoxy) which can all either inherently or as an obvious optimization of adhesive properties be present within the claimed ranges of proportions. Additionally, a suitable curing agent for curing the epoxy may also be present. With respect to the presence of a suitable thermoplastic polymer having the required claimed functions, it is noted that Appellants' specification teaches (page 3, second complete paragraph)

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"preferred thermoplastics include polybutadienes, and the like, including copolymers thereof" and also other thermoplastic polymers may include "polyolefins". Note that JP -060 Abstract clearly teaches that either polyethylene, polypropylene, polybutadiene, or ethylene/butadiene thermoplastic resins are particularly suitable. With respect to the absence of a "photocured epoxy", the Examiner notes that for the purpose of an obviousness rejection, the teaching of a "curing agent" for the thermosetting resin, which resin can be an epoxy resin in the reference is believed to put the presence of a "photocured epoxy" well within the ordinary skill of the art, and note that Appellants have also failed to prove on the record that a "photocured" epoxy (a product-by-process limitation) produces a patentably distinct article.

22. Claims 1, 2, 7-10, 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Abstract -059. The reference teaches a heat sensitive pressure sensitive adhesive genus of compositions which can include the presence of a thermoplastic polymer having substantially no epoxy binding functions or ester functions, as well as a tackifier and an epoxy compound, together with the presence of a thermal hardening agent suitable for curing the epoxy compound. Note also that the thermoplastic resin can be a "styrene monomer" which are again extensively taught in the specification at page 3, second

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complete paragraph as particularly preferred thermoplastic polymers. Additionally, it is believed that the range of proportions of the various components would again be, if not inherent, an obvious optimization of properties to one of ordinary skill in the heat sensitive pressure sensitive adhesive art. Although the -059 Abstract fails to teach a "photocured epoxy", it must be noted particularly for purposes of an obviousness rejection that the presence of a thermal hardening agent which is an epoxy compound is again believed to put the claimed "photocured epoxy" well within the ordinary skill of the art.

23. (11) *Response to Argument*

The Examiner initially notes that Appellants, particularly in their Summary and the second complete paragraph on page 5 of their Brief extensively allege improved extrusion properties for their adhesive composition as well as "improved adhesive properties". Additionally, they further allege (Brief page 6, first complete paragraph) the "critical limitation" of including a photocured epoxy component. The Examiner respectfully submits, however, that nowhere on the record has any sort of comparison ever been made against any of those compositions which the Examiner relies upon as the "closest prior art". As such, Appellants' arguments are entitled to little, if any substantive weight on this particular point.

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As was earlier pointed out in the Examiner's prior art rejections, Appellants have extensively argued that neither of the cited references "disclosed the critical limitation of excluding epoxy-binding or ester functions from the thermoplastic polymer component of the composition - to the contrary, they teach numerous examples that include such functional groups" (Brief, page 5, third complete paragraph). However, the Examiner can only note that one of his references teaches at least four species of thermoplastic polymers which are expressly taught in Appellants' specification as being particularly preferred. Additionally, the other reference (⁹59 Abstract) teaches the presence of a "styrene monomer" which is also extensively taught as being particularly suitable in a number of embodiments set forth in Appellants' specification. It must thus again be noted that Appellants' arguments on this critical point are again entitled to little, if any substantive weight.

Appellants' arguments (Brief, paragraph bridging pages 5 and 6) regarding allegations that U.S. Patent No. 4,522,965, which has not been relied upon by the Examiner somehow negates the Examiner's rejection again is believed to be little more than an attempt to avoid the clear and unambiguous language of the relied upon references.

Finally, the Examiner notes that Appellants have again challenged the Examiner's assertion that a "self-adhesive" is

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known to be identical with a "pressure sensitive adhesive". The Examiner has not supplied a reference only because it is so strongly believed that the two terms are so well known in the art to be equivalents to one another (such as, e.g. H₂O and water) as to not necessitate the presence of a reference to prove an elementary point.

In summary, it is respectfully submitted that Appellants have failed to overcome the prima facie case of record.

25. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zinker

DRZirker:cdc
(703) 308-0031
October 10, 2002

Philip Y. Dahl
Office of Intellectual Property Counsel
3M Innovative Properties Co.
P.O. Box 33427
St. Paul, MN 55133-3427

APPEAL CONFeree: *GW Keagy*

APPEAL CONFeree: *T. Morris FM*